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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,102	04/13/2004	Jan Batzer	104035.277308	6148

7055 7590 12/29/2010  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER
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WEBB, WALTER E

ART UNIT	PAPER NUMBER
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1612

NOTIFICATION DATE	DELIVERY MODE
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12/29/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/824,102	<b>Applicant(s)</b> BATZER ET AL.	
	<b>Examiner</b> WALTER E. WEBB	<b>Art Unit</b> 1612	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 56-110 is/are pending in the application.
- 4a) Of the above claim(s) 58-73,76,80-95,98-105 and 107-110 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56,57,74,75,77-79,96,97 and 106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/4/2010 has been entered.

Applicants' arguments, filed 8/4/2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Election/Restrictions***

Applicant's election of a W/O emulsion, tocopheryl acetate and Tinosorb S in the reply filed on 12/15/2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 58-73, 76, 80-95, 98-105 and 107-110 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 103***

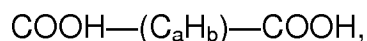
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1) Claims 56, 57, 77-79, 96, 97 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding et al., (US 5,705,144) in view of Wenzel et al., (US 6,143,532) as evidenced by Science Lab.com (Chemicals & Laboratory Equipment).

Harding et al. teaches a topical composition to promote the repair of photodamaged skin and/or to reduce or prevent the damaging effects of ultra-violet lighe on skin comprising retinol (**antioxidant**) or a derivative thereof and a dioic acid (see Abstract). The dioic acid has the general structure of



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where **a** is an integer from 6 to 20 and **b** is an integer from 8 to 40 (see abstract and col. 2, lines 10-26). The compound 8-hexadecene-1,16-dicarboxylic acid is a species of the dioic acid of Harding et al. where **a** is 16 and **b** is 30. The reference teaches an effective amount of dioic acid from 0.1 to 30% (see col. 3, line 25), as well as adding an antioxidant such as butylated hydroxytoluene, as per claim 57 (claim 11, lines 19-22). A particular convenient form of the composition is an emulsion, “in which case an oil or oily material will normally be present, together with an emulsifier to provide either a **water-in-oil emulsion** or an oil-in-water emulsion” [emphasis added] (**claim 106**) (see col. 8, lines 39-45). The composition further comprises a UV filter substance, as per claims 96 and 97, insofar the reference teaches use of organic sunscreens and ultrafine titanium dioxide for protection of the skin against UV-A and UV-B rays (see Table 1 at col. 6, and col. 7, lines 41-45). Since the composition is taught to be a water-in-oil emulsion it is expected to have an aqueous phase, and the sunscreen, octyl methoxycinnamate is a liquid at room temperature (see Science Lab.com, MSDS at pg. 3).

Harding et al. differs from the instant claims insofar as it does not teach that the dioic acid is 8-hexadecene-1,16-dicarboxylic acid.

The claimed species would have been obvious to one of ordinary skill in the art at the time of applicant's invention especially since the reference teaches cis-7-hexadecene dioic acid as a predicted product formed when using oleic acid as a substrate. Furthermore, the prior art specifically teaches making 8-hexadecene-1,16-

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dicarboxylic acid, which is also known as 9-octadecenedioic acid, using oleic acid as a substrate (see Wenzel et al., at col. 4, lines 4-18, and Example 1 at col. 5, lines 15-20).

Generally, in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists (MPEP 2144.05).

Since the prior art range of dioic acid, i.e. from 0.1 to 30%, overlaps with the claimed ranges (claims 77-79), a *prima facie* case of obviousness exists.

2) Claims 74, 75 rejected under 35 U.S.C. 103(a) as being unpatentable over Harding et al., (US 5,705,144) in view of Wenzel et al., (US 6,143,532) as applied to claims 56, 57, 77-79, 96, 97 and 106 above, and further in view of Nachbar et al., (J Mol Med 1995).

The combination of Harding and Wenzel et al., taught above, differs from claims 74 and 75 insofar as it does not teach where the antioxidant is vitamin E.

Nachbar et al. teaches the use of vitamin E as an antioxidant for treating damaged skin, e.g. photoaging (see Abstract). Nachbar et al. teaches the use of the "antioxidative photoprotective agent" **tocopheryl acetate** topically ranging from 0.02% to 0.5% (see pg. 12, left column, 2nd paragraph), which overlaps with instant claimed range for the amount of vitamin E.

Generally, it is obvious to replace one component for another equivalent component if it is recognized in the art that two components are equivalent and is not based on the Applicant's disclosure (see MPEP 2144.06). It is also *prima facie* obvious to select a known material based on its suitability for its intended use (see MPEP

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2144.07). Also, established precedent holds that it is generally obvious to add known ingredients to known compositions with the expectation of obtaining their known function (see 2144.06). Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to use the vitamin E antioxidant of Nachbar et al. as the antioxidant in the composition of Harding et al. based on its suitability for its intended use.

### ***Response to Arguments***

Applicant's arguments with respect to claims 56, 57, 74, 75, 77-79, 96, 97 and 106 have been considered but are moot in view of the new ground(s) of rejection.

### ***Nonstatutory Obvious-type Double Patenting--previous***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1) Claims 56 and 57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable of claims 1 and 13 (rewritten as claims 44 and 55) of copending Application 11/087,395 and claims 1 and 5 of copending application 11/547,104.

Claims 1 and 2 are not patentably distinct from claims 44 and 55 of the '395 application and claims 1 and 5 of the '104 application insofar as both copending applications claim cosmetic preparations comprising 8-hexadecene-1,16-dicarboxylic acid and an antioxidant.

This is a provisional double patenting rejection since the conflicting claims have not been patented.

2) Claims 56, 57, 74, 75, 96 and 97 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 17 of U.S. Patent No. 7,341,712. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a cosmetic composition comprising 8-hexadecene-1,16-dicarboxylic acid and a UV filter substance. The '712 patent does not claim an antioxidant but embodiments of the invention use known antioxidants such as tocopherol acetate (see col. 33, Example 9).



The claims are obvious over the claims above insofar as the claims are directed to dermatological preparations comprising 8-hexadecene-1,16-dicarboxylic acid and alpha lipoic acid.

3) Claims 56 and 57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 17 of U.S. Patent No. 7,820,177. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a cosmetic composition comprising 8-hexadecene-1,16-dicarboxylic acid. The '177 patent does not claim an antioxidant but claim 9 recites known antioxidants such as lipoic acid and vitamin C.

The claims are obvious over the claims above insofar as the claims are directed to dermatological preparations comprising 8-hexadecene-1,16-dicarboxylic acid and an antioxidant.

### ***Technological Background***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US patent application 2002/0054891 to Anderson et al. The reference is pertinent for teaching **Tinosorb S** as a suitable sunscreen in a cosmetic composition (see table of paragraph [0032] at pg. 3).

### ***Correspondence***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter E. Webb whose telephone number is (571) 270-3287. The examiner can normally be reached on 8:00am-4:00pm Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Walter E. Webb  
/Walter E Webb/  
Examiner, Art Unit 1612